



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,621	08/07/2001	Satoru Matsuda	112857-282	3175

29175 7590 01/26/2007
BELL, BOYD & LLOYD, LLP
P. O. BOX 1135
CHICAGO, IL 60690

EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
----------	--------------

2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/924,621

Applicant(s)

MATSUDA ET AL.

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-18 and 35 are presented for examination. Claims 19-34 have been withdrawn from the consideration.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/06/2006 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2154

4. Independent claims 1, 15, 16, 35 and their dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The various steps conversion, substituting, recording and searching are software constructs (software per se) performing various functionalities. These functionalities do not manipulate any hardware or tangible entity. Therefore, these software constructs are non statutory entities as detailed in MPEP 2106.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-18 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Summers et al (6,816,884) (hereinafter Summers).

7. As per claim 1, Summers discloses an information processing device which exchanges a plurality of information with other information processing devices via a network, said information processing device comprising:

first input/output control means for controlling input and output of information to and from a first information processing device of a user (220n, fig 1, col 4, lines 37-67);

second input/output control means for controlling input and output of information to and from a second information processing device (220a, fig 1, col 4, lines 37-67);

a conversion (replaces, col 11, lines 14-16) means for converting personal information (email address, col 11, lines 14-16) contained in a first information of which input is controlled by said first input/output control means with a second information (community, col 11, lines 14-41), the second information corresponding to a predetermined group (fig 3) to which said user belongs (col 11, lines 9-41);

a substituting (replaces, col 11, lines 14-16) means for substituting the personal information of said user contained in first information with the second information (email address, col 11, lines 14-16), prior to sending the

Art Unit: 2154

first information to said second information processing device (col 11, lines 9-41), the second information also corresponding to said personal information of said user on a one-to-one basis (nick name , col 11, lines 9-41);

first recording control means for controlling recording of said personal information of said user and said second information said personal information of said user and said second information being recorded in a corresponding manner (20-27, fig 2, and 33C, 33A, fig 3, col 9, line 54 to col 10, line 8); and

searching (find, col 11, line 49) means for locating the personal information corresponding to the second information prior to sending a reply, to said first information, from said second information processing device to said first information processing device (col 11, lines 25-65),

wherein said user is registered as a member of the predetermined group (20-27, fig 2, and 33C, 33A, fig 3, col 9, line 54 to col 10, line 8); and

wherein said second information is determined corresponding to said group (fig 6, col 11, lines 9-41), and said second input/output control means controls output to said second information processing device of said first information (fig 6, col 11, lines 9-41), said personal information of said user

Art Unit: 2154

is substituted with said second information by said substituting means (fig 6, col 11, lines 9-41).

8. As per claim 2, Summers discloses personal information of said user is an e-mail address of said user (email address, col 9, line 9-41).

9. As per claim 3, Summers discloses generating means for generating said second information using a hash function (user identifier, col 13, lines 35-49).

10. As per claim 4, Summers discloses searching means for searching operational information of said user regarding which recording is controlled by said first recording means (col 11, lines 9-41) based on said second information contained in a third information which is a reply to said first information regarding which input is controlled by said second input/output control means (fig 6, col 13, lines 10-67); wherein said first input/output control means controls output of said third information to said first other information processing device, based on said personal information of said users searched by said searching means (user profile, fig 6, col 13, lines 10-

67).

11. As per claim 5, Summers discloses second recording control means for controlling recording of personal attributes information of said user (user profile, fig 6, col 13, lines 10-67); and third recording control means for controlling recording of information identifying said group and attribute information of said group (community, fig 6, col 13, lines 10-67); wherein said attribute information of said group contains (fig 6), of said personal attribute information regarding which recording is controlled by said second recording control means (user profile, fig 6, col 13, lines 10-67); a predetermined number of sets of personal attribute information common to a plurality of said users registered to said group, in descending order of degree held in common (fig 2-3, col 9, line 4 to col 10, line 20).

12. As per claim 6, Summers discloses further comprising verifying means for verifying permission for access to said attribute information of said group regarding which recording is controlled by said third recording control means (fig 2-3, col 9, line 4 to col 10, line 20); wherein said verifying means verifies permission for access to said attribute information of said group based on a contract between said group and the holder of said second other

information processing device (fig 2-3, col 9, line 4 to col 10, line 20).

13. As per claim 7, Summers discloses searching means for searching for said attribute information of said group regarding which recording is controlled by said third recording control means, based on information for identifying said group regarding which input is controlled by said second input/output control means, in the event that said verifying means verifies the permission to access of said second other information processing device (fig 2-3, col 9, line 4 to col 10, line 20); wherein said second input/output control means controls output of said attribute information of said group searched by said searching means, to said second other information processing device (fig 2-6, col 11, lines 9-65).

14. As per claim 8, Summers discloses searching means for searching for information for identifying said group regarding which recording is controlled by said third recording control means, based on information corresponding to said attribute information of said group contained in a fourth information regarding which input is controlled by said second input/output control means, in the event that said verifying means verifies the permission to access of said second other information processing device (fig 2-6, col 8, lines 22-67).

15. As per claim 9, Summers discloses second input/output control means controls the output of information for identifying said group searched by said searching means to said second other information processing device (fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

16. As per claim 10, Summers discloses first input/output control means controls the output of said fourth information to said first other information processing device which said user registered to said group has, based on information for identifying said group searched by said searching means (fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

17. As per claim 11, Summers discloses third input/output control means for controlling input and output of information to and from a third other information processing device (fig 2-6, col 8, lines 22-67; col 11, lines 9-65); verifying means for verifying permission to access personal attribute information of said user regarding which recording is controlled by said second recording control means (fig 2-6, col 8, lines 22-67; col 11, lines 9-65); and first searching means for searching said personal attribute information of said user regarding which recording is controlled by said second recording control means (fig 2-6, col 8, lines 22-67; col 11, lines 9-

65), based on fifth information regarding which input is controlled by said third input/output control means, in the event that said verifying means verifies permission to access a third other information processing device (fig 2-6, col 8, lines 22-67; col 11, lines 9-65); wherein said third input/output control means controls the output of said personal attribute information of said user searched by said first searching means to said third other information processing device (fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

18. As per claim 12, Summers discloses verifying means verifies permission for access to said personal attribute information of said user registered to said group, based on a contract between the holder of said third other information processing device and said group (fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

19. As per claim 13, the claim is rejected for the same reasons as claim 1, above. In addition, Summers discloses second searching means for searching for said holder of said third other information processing device which has entered into contract with said group (registered with the group, fig 2-6, col 8, lines 22-67; col 11, lines 9-65), based on said second information regarding which input is controlled by said second input/output

control means (fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

20. As per claim 14, the claim is rejected for the same reasons as claim 1, above.

21. As per claim 15, the claim is rejected for the same reasons as claim 1, above.

22. As per claim 16, the claim is rejected for the same reasons as claim 1, above. In addition Summers discloses wherein said second information processing device comprises: third input/output control means for controlling input and output of information from and to said first information processing device (220n, fig 2-6, col 8, lines 22-67; col 11, lines 9-65);

wherein said third input/output control means controls output of said first information to said first information processing device (236, fig 2-6, col 8, lines 22-67; col 11, lines 9-65); and

wherein said third information processing device comprises: fourth input/output control means for controlling input and output of information from and to said first information processing device (235, fig 2-6, col 8, lines 22-67; col 11, lines 9-65);

wherein said fourth input/output control means controls input of said first information from said first information processing device (236m, fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

23. As per claim 17, the claim is rejected for the same reasons as claim 16, above. In addition Summers discloses said first information processing device further comprises generating means for generating said second information using a hash function (user identifier, col 13, lines 35-49, hash function is interpreted as an algorithm that transforms a string of characters into a usually shorter value of a fixed length or a key that represents the original value, for example nick name); and

wherein said third information processing device distinguishes said user having said second information processing device which has output said first information to said first information processing device, based on said second information contained in said first information regarding which input is controlled by said fourth input/output control means (process flow, fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

24. As per claim 18, the claim is rejected for the same reasons as claim 16, above. In addition Summers discloses with said third information processing device, said fourth input/output control means control output of a

third information which is a reply to said first information containing said second information (process flow, fig 2-6, col 8, lines 22-67; col 11, lines 9-65).

25. As per claim 35, the claim is rejected for the same reasons as claims 16 and 18, above.

Response to Arguments

26. Applicant's arguments with respect to claims 1-18 and 35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent 7,069,249

U.S. Patent 6,078,949

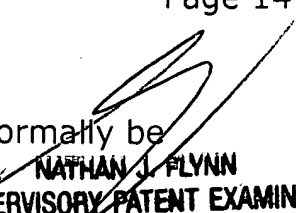
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose

Application/Control Number: 09/924,621

Page 14

Art Unit: 2154

telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.


NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS